

REMARKS

Claims 1 through 60 are pending in this reissue application. The Applicant appreciates the allowance of claims 1-10 and 49-54.

The Office action mailed on 4 June 2002 (Paper No. 5) provided by the Examiner has been read and given careful consideration.

A.

On page 2 of Paper No. 5, the Examiner objects to the oath/declaration of the assignee because "the assignee has offered to surrender original patent and a statement as to loss or inaccessibility of the original patent. The Assignee can offer to surrender the original patent or state the original patent is lost or inaccessible, but cannot do both at the same time (MPEP 1416 and 37 CFR 1.178)."

The Applicant thanks the Examiner on this point regarding 37 C.F.R. § 1.178(a). In response to the Examiner's objection, the Applicant has revised the oath/declaration by the assignee and has also revised the oath/declaration by the inventor. At the top of the third page of each respective oath/declaration, it is now stated that "the original grant of the patent has become lost or inaccessible."

The Applicant respectfully believes that the new oath/declaration complies with 37 C.F.R. § 1.178(a). In view of the newly submitted documents, the Applicant respectfully

requests that the objections be withdrawn.

B.

On pages 2-3 of Paper No. 5, the Examiner objects to the combined declaration and consent of the assignee because "the assignee failed to establish ownership in accordance with 37 CFR 1.172(a) and 3.73(b). There is no documentary evidence showing chain of title from the original owner to the assignee. Only an incomplete statement specifying where documentary evidence of the same is recorded in the assignment records of the Office without the reel and frame number has been submitted."

The Applicant thanks the Examiner on this point regarding 37 C.F.R. §§ 1.172(a) and 3.73(b)(1). In response to the Examiner's objection, the Applicant has revised the oath/declaration by the assignee. On the third page of the oath/declaration, it is now stated that "the assignee of U.S. Patent No. 5,944,830 by virtue of an Assignment from all inventors recorded in the U.S. Patent & Trademark Office at Reel No. 011958, at Frame No. 0218 on the 9th day of July 2001, consents to the filing of this reissue application for the reissue of U.S. Patent No. 5,944,830."

The Applicant respectfully believes that the new oath/declaration complies with 37 C.F.R. §§ 1.172(a) and 3.73(b)(1). In view of the new oath/declaration, the Applicant respectfully requests that the objection to the oath/declaration be withdrawn.

C.

On page 2 of Paper No. 5, the Examiner asserts that the oath/declaration is defective because it fails to satisfy the requirements of 37 C.F.R. § 1.175(a)(1). The Applicant respectfully disagrees with the Examiner. The Applicant respectfully believes that the oath/declaration fully complies with the requirements of 37 C.F.R. § 1.175(a)(1).

On page 2 of Paper No. 5, the Examiner objects to the oath/declaration by stating the following:

The reissue oath/declaration filed with this application is defective because it fails to contain the statement required under 37 CFR 1.175(a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid. See 37 CFR 1.175(a)(1) and see MPEP § 1414. The declaration includes a statement that the error was in claiming more or less than the applicant had a right to claim in the original patent. However, the declarant does not describe how the error renders the original patent wholly or partly 'inoperative' or 'invalid' (MPEP 1414(II)). The statement of claiming more or less does not clearly describe the error in the original patent. Also the applicant refers to claim language, but this language does not explain whether applicant claimed more or less in the original patent. Applicant needs to state that either more or less than the applicant had right to claim (but not both) was claimed in the original patent.

The Examiner's objection to the oath/declaration is believed to be improper because the oath/declaration does satisfy the requirements of 37 C.F.R. § 1.175(a)(1). The Examiner instructs the Applicant to see 37 C.F.R. § 1.175(a)(1) and M.P.E.P. § 1414. After a review of those sections, it is apparent that the Examiner's objection is improper. Let's examine 37 C.F.R.

§ 1.175(a)(1) and M.P.E.P. § 1414.

37 C.F.R. § 1.175(a)(1) states that “The reissue oath or declaration ... must also state that:
(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of ... the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue.”

The requirements of 37 C.F.R. § 1.175(a)(1) are discussed in M.P.E.P. § 1414(I) as follows: “a declaration can state 'Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming more or less than patentee had the right to claim in the patent' The above examples will be sufficient to satisfy this requirement without any further statement.”

The Examiner specifically refers to M.P.E.P. § 1414(II). Let's examine that section now. M.P.E.P. § 1414(II) states “A reissue applicant must acknowledge the existence of an error See M.P.E.P. § 1402 for a discussion of grounds for filing a reissue that may constitute the 'error' required by 35 U.S.C. § 251.”

When we refer back to M.P.E.P. § 1402, as suggested by M.P.E.P. § 1414(II), we see that the requirements of 37 C.F.R. § 1.175(a)(1) are discussed in M.P.E.P. § 1402 as follows: “There must be at least one error in the patent to provide grounds for reissue of the patent The most

common bases for filing a reissue application are: (A) the claims are too narrow or too broad An attorney's failure to appreciate the full scope of the invention was held to be an error correctable through reissue."

In view of the foregoing, the Applicant respectfully submits that the oath/declaration satisfies the requirements of 37 C.F.R. § 1.175(a)(1). In December 2001, the Applicant filed a three-page oath/declaration entitled "Reissue Application Declaration by the Inventor." On the first page of the oath/declaration, it states "I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below ... by reason of the patentee claiming more or less than he had the right to claim in the patent."

In view of the section of M.P.E.P. § 1414 cited above, the Applicant respectfully believes that the requirements of 37 C.F.R. § 1.175(a)(1) have been fully met by the foregoing statement contained on the first page of the oath/declaration.

The aforementioned oath/declaration continues to a second page which provides even more information related to 37 C.F.R. § 1.175(a)(1). On the second page of the three-page oath/declaration, it states "**At least one error upon which reissue is based is described as follows:** ... I believe the original of aforesaid patent to be wholly or partly inoperative by reason of my claiming more or less than I had a right to claim in the original patent, due to errors in each of claims 1 through 10, and more specifically, by failing to more broadly claim my inventions as

disclosed and described in the original patent. Specifically, ... **independent claim 1 describes my invention too narrowly by claiming 'a power supply unit'** ... although my invention may be practiced 'to reduce power consumption of a color display tube' Accordingly, it is my intent and desire to obtain broader coverage of my inventions" (emphasis added).

In view of the foregoing, the Applicant respectfully believes that the oath/declaration satisfies the requirements of 37 C.F.R. § 1.175(a)(1). Accordingly, the Applicant respectfully submits that the Examiner's objections to the oath/declaration are improper and should be withdrawn.

D.

On page 3 of Paper No. 5, the Examiner rejects claims 11, 12, 17, 18, 21, 22, 25, 26, 31, 32, 35, 38, 43, 46, 55, and 56 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,870,086 issued to Bang.

The Examiner is indicating that Bang '086 is available to cite as "prior art" in a rejection of the claims of the present reissue application. However, the Applicant respectfully believes that Bang '086 is not available to cite as "prior art" in a rejection of the claims of the present reissue application because the parent application of the present reissue application was filed in the U.S. on 10 March 1997 and because of the **claim of foreign priority** in the present reissue application.

Let's examine this issue. "A person shall be entitled to a patent unless ... (e) The invention was described in ... an application for patent ... by another filed in the United States before the invention by the applicant for patent" (35 U.S.C. § 102(e)).

The parent of the present reissue application was filed on 10 March 1997 which is **before** the filing date of Bang '096 (14 August 1997).

"The filing date of the foreign priority document may be used to overcome certain references" (M.P.E.P. § 706.02). "A rejection under 35 U.S.C. § 102(e) can be overcome by: ... (E) Perfecting a claim to priority under 35 U.S.C. 119(a)-(d). The foreign priority filing data must **antedate the reference** and be **perfected**" (M.P.E.P. § 706.02(b) (emphasis added)).

The Applicant respectfully submits that the claim for foreign priority in the present reissue application can be perfected, because the present reissue application and oath/declaration fully satisfy the guidelines set forth in M.P.E.P. § 1417 regarding perfecting the claim for foreign priority.

"A 'claim' for the benefit of an earlier filing date in a foreign country under 35 U.S.C. § 119(a)-(d) must be made in a reissue application, even though such a claim was previously made in the application on which the original patent was granted" (M.P.E.P. § 1417).

The Applicant respectfully submits that both the 10 March 1997 U.S. filing date of the parent application, and the 8 March 1996 filing date of Applicant's Korean priority application Serial Nos. 6135/1996 and 4299/1996 claimed for foreign priority in the present reissue application, antedates Bang '086 and its later 14 August 1997 filing date. The claim for foreign priority is based upon two foreign applications filed on **8 March 1996**, and the parent of the applicant's U.S. application was filed on 10 March 1997 with timely claims for priority on Korean priority application Nos. 6135/1996 and 4299/1996.

“A U.S. patent reference is effective prior art as of its U.S. filing date” (M.P.E.P. § 2136.03(I)). The U.S. filing date for Bang '086 is 14 August 1997. Therefore, because 8 March 1996 and 10 March 1997 are before 14 August 1997, the claim for foreign priority and the U.S. filing date of the present reissue application antedate Bang '086. In view of the foregoing, the Applicant respectfully submits that Bang '086 is not available to cite as “prior art” in a rejection of the claims of the present reissue application because of the claim of foreign priority in the present reissue application. Therefore, the § 102 rejection of claims is believed to be improper. The Applicant respectfully requests that the Examiner withdraw the § 102 rejection of claims 11, 12, 17, 18, 21, 22, 25, 26, 31, 32, 35, 38, 43, 46, 55, and 56.

E.

On page 4 of Paper No. 5, the Examiner rejects claims 13-16, 19, 20, 23, 24, 27-30, 33, 34, 36, 37, 39-42, 44, 45, 47, 48, and 57-60 under 35 U.S.C. § 103(a) as being unpatentable over

Bang '086 in view of Applicant's admitted prior art.

The Examiner is indicating that Bang '086 is available to cite as “prior art” in a rejection of the claims of the present reissue application. However, the Applicant respectfully believes that Bang '086 is not available to cite as “prior art” in a rejection of the claims of the present reissue application because of the U.S. filing date (10 March 1997) and the claim of foreign priority in the present reissue application.

The Applicant demonstrated hereinabove that Bang '086 was not available to cite as “prior art” in a § 102 rejection of claims of the present reissue application. If a reference is not available to cite as “prior art” in a § 102 rejection of claims of the present reissue application, then that reference also is not available to cite as “prior art” in a § 103 rejection of claims in the same reissue application.

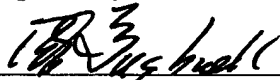
In view of the foregoing, the Applicant respectfully submits that Bang '086 is not available to cite as “prior art” in a rejection of the claims of the present reissue application because of the claim of foreign priority in the present reissue application.

Therefore, the § 103 rejection of claims is believed to be improper. The Applicant respectfully requests that the Examiner withdraw the § 103 rejection of claims 13-16, 19, 20, 23, 24, 27-30, 33, 34, 36, 37, 39-42, 44, 45, 47, 48, and 57-60.

On page 6 of Paper No. 5, the Examiner states "The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892." The Applicant does not concede that all of the references made of record can be cited as "prior art" against claims of the present reissue application. Numerous references were made of record by the Examiner but not utilized in the rejection of the claims. As recognized by the Examiner, these references fail to teach or suggest the specifically recited features of the present invention and accordingly, the Applicant respectfully believes that no further comment on these references is necessary at this time.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,



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